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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/873,235  | 06/05/2001  | Hiromi Ohara         | 109697              | 4542             |
| 25944   | 7590        | 06/27/2005           | EXAMINER            |                  |
| OLIFF & BERRIDGE, PLC<br>P.O. BOX 19928<br>ALEXANDRIA, VA 22320 |             |                      | PARK, CHAN S        |                  |
|   |             | ART UNIT             |                     | PAPER NUMBER     |
|   |             | 2622                 |                     |                  |

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                          |                  |
|------------------------------|--------------------------|------------------|
| <b>Office Action Summary</b> | Application No.          | Applicant(s)     |
|                              | 09/873,235               | OHARA, HIROMI    |
|                              | Examiner<br>CHAN S. PARK | Art Unit<br>2622 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 14 February 2005.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 July 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>5</u> .<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>6) <input type="checkbox"/> Other: _____. |
|--|---|

## DETAILED ACTION

### ***Response to Amendment***

1. Applicant's amendment was received on 2/14/05, and has been entered and made of record. Currently, **claims 1-12** are pending.

### ***Response to Arguments***

Applicant's arguments regarding 35 U.S.C. § 112 have been fully considered but they are not persuasive.

2. Claims 3 and 9, as currently amended, still do not clarify to withdraw the rejection under 35 U.S.C. § 112.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant states "the produced image data is being stored inside the scanner device". If the produced image data is stored inside the scanner device, the examiner finds no supporting evidence that shows the scanner transmitting its own location/address to the printing management device.

Referring to fig. 3B of the original Drawings filed on 7/2/05, it clearly indicates that

the produced image data is external device such as the 'Scanserver'. The applicant's disclosure only shows the storing location being the memory location of the scanserver. The Examiner respectfully requests the applicant to show a specific step or feature where the location information of the scanner is transmitted to the printing management device either from the Specification or the Drawings.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The claims recite that the printing management device includes the transmission control means for transmitting the image data. However, it is uncertain as to how this image data, which was never received by the printing management device, can be transmitted by the transmission control means of the printing management device. What exactly is transmitted by the transmission control mean? Is the image data transmitted to the printer via the printing management device? If yes, where is it disclosed in the Specification?

Applicant's arguments filed 2/14/05 have been fully considered but they are not persuasive.

4. In response to the applicant's arguments regarding the rejection of claims 1 and 7, wherein on pages 10-12, the applicant explains how the current invention differs from the teachings of Owa. Particularly, the applicant states that the current invention has, for example, an image input device, i.e., a scanner, that is used to produce image data. The examiner notes that the host computer 1 of Owa can still be interpreted as the image input device. Referring to the applicant's Specification, whereon page 7, lines 20-21, it states that "the input portion 11 receives image data or printing request from the scanner 2 or the client 4". Thus, the applicant acknowledges that a host computer (client 4) can be used as the image input device to input image. Furthermore, the host computer of Owa does produce image data corresponding to the printing instruction information set by the printing instruction information setting means (col. 4, lines 44-48). Print data (image data) of a document containing images (col. 4, lines 42-43) is produced/generated by the print data generation section.

Owa, however, does not disclose expressly that the printing management device receives the image data and transmits the image data to the selected optimum/desired printer.

Bellucco (U.S. Patent No. 5,930,465) discloses a printing system (fig. 1) comprising an image input device, multiple printers, and a printing management device receiving printing instruction information and transmitting printing information corresponding to the printing instruction information to a corresponding printer among the multiple printers,

the image input device (clients 15 in fig. 1) comprising:

printing instruction information setting means (UI 16 in fig. 2) for setting printing instruction information including specification of a desired printer among the multiple printers (col. 4, lines 27-36);

image data producing means for producing image data corresponding to the printing instruction information set by the printing instruction information setting means (col. 4, lines 7-12 and lines 27-36); and

transmitting means (connection between the clients 15 and the server 15) for transmitting the printing instruction information set by the printing instruction information setting means and the image data produced by the image data producing means to the printing management device (col. 4, lines 27-36 and fig. 1), and

the printing management device (server 25) for storing the image data in a storage (file 43) and transmitting the image data to an appropriate printer.

The server 25 of Bellucco clearly stores the image data transmitted from the host computer for the further transmission to the printer.

Owa and Bellucco are analogous art because they are from the same field of endeavor that is the network printer.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the image data transmitting server to a printer of Bellucco into the printing system of Owa.

The suggestion/motivation for doing so would have been to provide a server that transmits the image data to an optimum printer upon selecting the optimum printer for a particular print job (col. 4, lines 46-64 of Bellucco).

Therefore, it would have been obvious to combine Owa with Bellucco to obtain the invention as specified in claims 1 and 7.

5. Therefore, the rejection of claims 1 and 7 is maintained and repeated in this Office action.

6. Applicant's arguments with respect to claims 3 and 9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Drawings***

7. The drawings are objected to under 37 CFR 1.83(a) because they fail to show transmitting a scanner location to the printing management device. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after

the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

8. Claims 9 and 10 are objected to because of the following informalities:  
"image data" should be -- the produced image data -- throughout the claims.  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owa in view of Bellucco et al. U.S. Patent No. 5,930,465 (hereinafter Bellucco).

9. With respect to claim 1, Owa discloses a printing system (fig. 2) comprising an image input device, multiple printers, and a printing management device receiving

printing instruction information and transmitting printing information corresponding to the printing instruction information to a corresponding printer among the multiple printers,

the image input device (host computer 1 in fig. 2) comprising:

printing instruction information setting means (print condition input section 14) for setting printing instruction information including specification of a desired printer among the multiple printers (col. 4, lines 17-33 & col. 12, lines 35-44);

image data producing means (print data generation section 18) for producing image data corresponding to the printing instruction information set by the printing instruction information setting means (col. 4, lines 44-48); and

transmitting means (data transfer system 17) for transmitting the printing instruction information set by the printing instruction information setting means (col. 4, lines 48-52 & col. 17, lines 41-42 and 47-50) to the printing management device (server 3), and

the printing management device (col. 17, lines 35-58) comprising:

storage management means for storing and managing the printing instruction information transmitted from the transmitting means in association with each other (the information must be stored in a memory for selecting the optimum printer in col. 17, lines 44-51 & col. 3, lines 41-50); and

transmission control means for transmitting the selected optimum printer information to the host (col. 17, lines 50-51).

Owa, however, does not disclose expressly that the printing management device receives the image data and transmits the image data to the selected optimum/desired printer.

Bellucco, on the other hand, discloses a printing system (fig. 1) comprising an image input device, multiple printers, and a printing management device receiving printing instruction information and transmitting printing information corresponding to the printing instruction information to a corresponding printer among the multiple printers,

the image input device (clients 15 in fig. 1) comprising:

printing instruction information setting means (UI 16 in fig. 2) for setting printing instruction information including specification of a desired printer among the multiple printers (col. 4, lines 27-36);

image data producing means for producing image data corresponding to the printing instruction information set by the printing instruction information setting means (col. 4, lines 7-12 and lines 27-36); and

transmitting means (connection between the clients 15 and the server 15) for transmitting the printing instruction information set by the printing instruction information setting means and *the image data produced by the image data producing means to the printing management device* (col. 4, lines 27-36 and fig. 1), and

*the printing management device (server 25) for storing the image data in a storage (file 43) and transmitting the image data to an appropriate printer.*

Owa and Bellucco are analogous art because they are from the same field of endeavor that is the network printer.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the image data transmitting server to a printer of Bellucco into the printing system of Owa.

The suggestion/motivation for doing so would have been to provide a server that transmits the image data to an optimum printer upon selecting the optimum printer for a particular print job (col. 4, lines 46-64 of Bellucco).

Therefore, it would have been obvious to combine Owa with Bellucco to obtain the invention as specified in claim 1.

10. With respect to claim 2, Owa further discloses the printing system wherein the printing instruction information setting means sets printing instruction information including specification of multiple desired printers (col. 12, lines 54-67), the image data producing means produces multiple pieces of image data corresponding to the respective multiple desired printers included in the printing instruction information set by the printing instruction information setting means (col. 4, lines 44-48 and S48 in fig. 11), and

the transmitting means transmits the printing instruction information to the printing management device (col. 4, lines 48-52 & col. 17, lines 41-42 and 47-50), and

Again, with the combination of Owa and Bellucco as presented for claim 1, the transmitting of the image data from the host/client to the server and the transmitting of the image data from the server to the optimum printers are disclosed and taught.

11. With respect to claim 5, Owa further discloses the printing system wherein the multiple printers have functions different from each other (fig. 3), and

the image data producing means produces multiple pieces of image data corresponding to the respective functions of the multiple printers (col. 4, lines 44-48).

12. With respect to claim 6, Owa further discloses the printing system wherein the printing instruction information setting means comprises:
  - outputting method specifying means for specifying an outputting method in a printer (fig. 12a);
    - printer list display means for displaying a list of selectable printers based on the outputting method specified by the outputting method specifying means (fig. 12b);
      - printer specifying means for specifying a desired printer in the list of displayed printers (fig. 12b); and
        - setting means for setting an output mode by the printer specified by the printer specifying means (figs. 12a & b).

13. With respect to claim 7, arguments analogous to those presented for claim 1, are applicable.

14. With respect to claim 8, arguments analogous to those presented for claim 2, are applicable.

15. With respect to claim 11, arguments analogous to those presented for claim 5, are applicable.

16. With respect to claim 12, arguments analogous to those presented for claim 6, are applicable.

Claims 3, 4, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owa in view of Ogawa et al. U.S. Patent No. 6,115,739 (hereinafter Ogawa).

17. With respect to claim 3, Owa discloses a printing system (fig. 2) comprising an image input device, multiple printers, and a printing management device receiving printing instruction information and transmitting printing information corresponding to the printing instruction information to a corresponding printer among the multiple printers,

the image input device (host computer 1 in fig. 2) comprising:

printing instruction information setting means (print condition input section 14) for setting printing instruction information including specification of a desired printer among the multiple printers (col. 4, lines 17-33 & col. 12, lines 35-44);

image data producing means (print data generation section 18) for producing image data corresponding to the printing instruction information set by the printing instruction information setting means (col. 4, lines 44-48);

storage management means for storing and managing the image data produced by the image data producing means (it is noted that the print data generated by 18 must be stored either permanently or temporarily); and

transmitting means for transmitting (data transfer system 17) the printing instruction information set by the printing instruction information setting means and information on a storing location of the image data produced by the image data producing means (col. 4, lines 48-52 & col. 17, lines 41-42 and 47-50) to the printing management device (server 3), and

the printing management device (col. 17, lines 35-58) comprising:

storage management means for storing and managing the printing instruction information and the information on the storing location of the image data transmitted from the transmission means in association with each other (the information must be stored in a memory for selecting the optimum printer in col. 17, lines 44-51 & col. 3, lines 41-50); and

transmission control means for transmitting the image data corresponding to the desired printer based on the printing instruction information stored and managed by the storage management means to the desired printer from the storing location of the image data indicated in the information on the storing location (col. 17, lines 50-51).

Again, referring to col. 17, lines 44-51, when the server is used and the output destination printer selection section 11, the basic information setting section 12, and the status monitor section 13 are installed in the server 3, the server selects the optimum printer based on the various conditions specified by the host. Moreover, based on the selection, the host sends the image data, which is apparently stored in the host, to the optimum printer for printing. Note that when the server selects the optimum printer and informs the host computer 1 (col. 17, lines 50-51), the server must be able to distinguish the host computer 1 among other host computers (line 38 and fig. 1). Hence, it is apparent to one of ordinary skill in the art that the server must be initially notified with the information on host computer which is the storing location of the image data. Without that information, the server would not be able to notify the selected result to the appropriate host.

Owa, however, does not disclose expressly that the image input device is a scanner device.

Ogawa, the same field of endeavor of the network printing system, discloses a scanner wherein the scanner initiates the printing of the scanned image using the printer directory stored in the file server.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the scanner of the Ogawa with the printing system of Owa.

The suggestion/motivation for doing so would have been to initiate the printing process without the presence of a host computer.

Therefore, it would have been obvious to combine Owa with Ogawa to obtain the invention as specified in claim 3.

18. With respect to claim 4, Owa discloses the printing system according to claim 3, wherein

the printing instruction information setting means sets printing instruction information including specification of multiple desired printers (col. 12, lines 54-67),

the image data producing means produces multiple pieces of image data corresponding to the respective multiple desired printers included in printing instruction information set by the printing instruction information setting means (col. 4, lines 44-48 and S48 in fig. 11),

the transmitting means transmits information on storing locations of the respective multiple pieces of image data together with the printing instruction

information to the printing management device (col. 4, lines 48-52 & col. 17, lines 41-42 and 47-50), and

the storage management means stores and manages the information on the storing locations of the multiple pieces of image data corresponding to the respective multiple desired printers (the information must be stored in a memory for selecting the optimum printer in col. 17, lines 44-51 & col. 3, lines 41-50).

Also, arguments analogous to those presented for claim 3, are applicable.

19. With respect to claim 9, arguments analogous to those presented for claim 3, are applicable.

20. With respect to claim 10, arguments analogous to those presented for claim 4, are applicable.

### ***Conclusion***

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
June 14, 2005

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